

REMARKS

This is a full and timely response to the outstanding final Office Action mailed November 17, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

A. Rejection of Claims 11-13, 15, 19, 24, and 25

Claims 11-13, 15, 19, 24, and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Al-Hussein* (U.S. Pat. No. 5,809,167) and *Lo et al.* ("Lo," U.S. Pat. No. 6,268,927). Applicant respectfully traverses this rejection.

1. The Al-Hussein Disclosure

Al-Hussein discloses a stand-alone "personal imaging computer system." *Al-Hussein*, column 5, lines 6-10. As described by *Al-Hussein*, the system takes the form of PICS equipment 20, which essentially comprises a facsimile machine having the capabilities of a computer. *Al-Hussein*, column 5, lines 23-38.

Notably, *Al-Hussein*'s PICS equipment 20 is not described as performing the functions of a printer. Instead, *Al-Hussein* describes additional printers 45, 56, which serve that function.

2. The Lo Disclosure

Lo discloses a computer-related form overlay method in which a printer 1 includes a mass storage device 3 that stores forms to which user data can be added so as to enable printing of a composite image. *Lo*, column 5, line 13 to column 6, line 2.

3. Applicant's Claims

(a) Claims 11-13 and 15

Applicant's claim 11 provides as follows (emphasis added):

11. A method practiced by a printer for printing a form, the method comprising:

accessing form imaging data from at least one store via a network with the printer,

retrieving the form imaging data from the at least one store with the printer,

merging the retrieved form imaging data with static form data already stored on the printer to generate a completed form; and

printing the form imaging data along with the already stored static form data together as a hard copy form, such that printing a hard copy form is possible without the need to send the static form data to the printer and such that a copy of the static form data need only be stored on the printer.

(i) Al-Hussein's "PICS Equipment 20"

As an initial matter regarding claim 11, the Examiner argues that Al-Hussein teaches a method "practiced by a printer". For support, the Examiner argues that "actions are performed by the printer itself, which comprises a general purpose computer". This is clearly not true. Column 5, lines 53-60 of the Al-Hussein reference, which the Examiner relies upon for the above statement, provides:

PICS equipment 20 includes a general purpose computer (described in further detail in FIG. 5) whereby an operator is able to scan in documents, segmentation-process and recognition-process the documents to create text files corresponding to text areas in the documents, print out

document images, manipulate document images and text files via trackball 36 and display screen 35, and send and receive documents and images via facsimile.

Al-Hussein, column 5, lines 53-60 (emphasis added). As is clear from the above excerpt, it is Al-Hussein's "PICS equipment 20" and not any "printer" that Al-Hussein describes as comprising a general purpose computer. As described above, the PICS equipment 20 essentially comprises a facsimile machine having the capabilities of a computer and is not described as performing the functions of a printer. That Al-Hussein's PICS equipment 20 does not comprise a printer is underscored by the fact that Al-Hussein describes separate printers 45 and 56 that provide the printer functionality. See *Al-Hussein*, column 6, lines 16-25; column 6, lines 45-53; Fig. 4.

(ii) Claimed Actions Performed by a "Printer"

Turning to the various actions recited in claim 11, Applicant asserts that, contrary to the Examiner's arguments, Al-Hussein fails to teach a "printer" that performs a method comprising "accessing form imaging data from at least one store via a network" and "retrieving the form imaging data from the at least one store". Although Al-Hussein generally describes a "print server 44 that provides print services to printers 45," that disclosure alone clearly does not equate to a teaching of accessing "form imaging data" from "at least one store via a network" or retrieving the form imaging data from the at least one store with a printer. Furthermore, as noted above, the disclosure contained in column 5 relied upon by the Examiner relates to functions of the PICS equipment 20, not the printers 45. Therefore, the Examiner fails to identify a teaching or suggestion within

the Al-Hussein reference of a "printer" that accesses and retrieves form imaging data from at least one store via a network.

Regarding the PICS equipment, given that Al-Hussein's PICS equipment 20 is essentially a facsimile machine, the equipment does not access or retrieve data and then print it. Instead, Al-Hussein's equipment 20 simply scans hard copy documents or receives fax transmissions. This fact is supported by Al-Hussein's discussions of accessing, retrieving, and printing provided in column 6:

By virtue of this arrangement, operators at one of the workstations 40 can scan in a document using PICS equipment 20, segmentation-process and recognition-process the document image so as to obtain a text file corresponding to text areas of the document, store the document image and associated text file on network disk 42, retrieve the document image and its associated text file for manipulation, if desired, at workstation 40, and print out the original or manipulated document image and text file on one of printers 45. . . .

Thus, for example, it is possible for one of workstations 57 to access the imaging capabilities of PICS equipment 20 via backbone 50 and modem transponder 49; likewise, it is possible for one of workstations 51 to retrieve a document image from network disk 42, subject it to segmentation and recognition processing on PICS equipment 20, receive and manipulate the results at workstation 51, and print out documentation on one of printers 56.

Al-Hussein, column 6, lines 16-25 and 45-53.

As can be appreciated from the above excerpt, Al-Hussein's equipment 20 is used to scan a document as a conventional facsimile machine. The only "accessing" and "retrieving" of data in Al-Hussein's system, however, is performed by the workstations 40,

not the equipment 20. For at least those reasons, the basic premise of the rejection is false.

(iii) Lack of Clarity of Rejection

As a further matter, Applicant objects to the rejection as unclear given that the Examiner appears to rely upon disclosure that relates *both* to Al-Hussein's "printers 45" and to "PICS equipment 20" in alleging that Al-Hussein teaches a "printer" that performs the various actions recited in claim 11. Given that the "printers 45" and the "PICS equipment 20" comprise *separate components*, Applicant requests that the Examiner clearly identify which of those components the Examiner relies upon as constituting Applicant's claimed "printer" and further limit citation of Al-Hussein teachings to those that relate to that particular component. As provided in MPEP 706.07, "[t]he Examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." In this case, the Examiner has not established a clear rejection. Therefore, Applicant has been denied a full opportunity to understand the basis for the rejection of Applicant's claims as well as a full opportunity to respond to those bases.

(iv) Combination of Al-Hussein and Lo

As noted above, the Examiner's rejection is unclear as to which of Al-Hussein's components is relied upon as comprising a "printer" as recited in Applicant's claims. Therefore, it is not clear whether the Examiner is arguing that it would have been obvious

to add the various functionalities described by Lo into Al-Hussein's "PICS equipment 20" or "printer 45." In view of the Examiner's reference to Al-Hussein's column 3, lines 51-55, which appears to pertain to the PICS equipment, Applicant presumes that the Examiner is arguing that it would have been obvious to provide the functionality of Lo's printer to Al-Hussein's PICS equipment 20. Applicant disagrees.

Given that, as described above, Al-Hussein's PICS equipment 20 is a facsimile machine and not a printer, it would not have been obvious to combine the printing functionalities of the Lo printer, including storing form data and merging user data received from another computer with that form data to the PICS equipment. Specifically, given that the functionalities performed by dedicated facsimile machines are quite different from those provided by printers, a person having ordinary skill in the art simply would not think to attribute printer functionalities (like printing forms from print ready data received from a PC) to Al-Hussein's PICS equipment 20 when Al-Hussein so clearly is describing a dedicated facsimile machine and explicitly chose to include *separate* printers in his system to provide printing functionality. Applicant accordingly submits that the rejection is flawed as comprising an improper combination under 35 U.S.C. § 103. Indeed, it appears clear that the Examiner has considered each limitation of Applicant's claims in a vacuum. As is well established in the law, such a piecemeal approach is improper and the Examiner must instead consider the claims as a whole. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987)(In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed").

(b) Claims 19, 24, and 25

Regarding independent claim 19, Applicant notes that neither Al-Hussein nor Lo teach or suggest “means provided on the printer for accessing form imaging data from at least one store via a network” or “means provided on the printer for retrieving the form imaging data from the at least one store” for reasons described above. Furthermore, there would have been no motivation to a person having ordinary skill in the art to add Lo’s form processing and printing functionalities to Al-Hussein’s equipment 20, also for reasons described above. Accordingly, claim 19 is allowable over Al-Hussein and Lo.

Regarding independent claim 24, Applicant notes that neither Al-Hussein nor Lo teach or suggest a “printer” comprising “logic configured to access form imaging data from at least one store via a network; retrieve the form imaging data, merge the received data with static form data already stored on printer to generate a completed form, and print the form imaging data along with the already stored static form data together as a hard copy form” for reasons described in the foregoing. Accordingly, claims 24 and 25 are allowable over Al-Hussein and Lo.

B. Rejection of Claims 14, 16-18, 20-23, 26, and 27

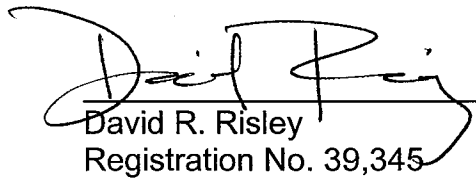
Claims 14, 16-18, 20-23, 26, and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Al-Hussein*, *Lo*, *LeClair et al.* (*LeClair*,” U.S. Pat. No. 6,636,891), and *Pennell et al.* (“*Pennell*,” U.S. Pat. No. 6,910,179). Applicant respectfully traverses this rejection.

As is identified above, Al-Hussein and Lo do not teach several aspects of Applicant's independent claims 11, 19, and 24. In that the LeClair and Pennell references do not remedy the deficiencies of the Al-Hussein and Yuasa references, Applicant respectfully submits that claims 14, 16-18, 20-23, 26, and 27 are allowable over the Al-Hussein/Lo/LeClair/Pennell combination for at least the same reasons that claims 11, 19, and 24 are allowable over Al-Hussein/Lo.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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